

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAN R. PFAFF

Appeal No. 96-1687
Application No. 08/192,067¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, ABRAMS and FRANKFORT, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-24, which constitute all of the claims of record in the application.

¹Application for patent filed February 3, 1994. According to appellant, this application is a continuation of Application 08/002,660, filed January 11, 1993, now abandoned.

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The appellant's invention is directed to a rotary die machine of the type used to cut blanks from a thin web of material passing through the nip of the dies. The subject matter before us on appeal is illustrated by reference to claim 1, which is reproduced in an appendix to the APPLICANT'S NEW BRIEF.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Bell et al. (Bell)	4,759,247	Jul. 26, 1988
Fokos et al. (Fokos)	5,001,950	Mar. 26, 1991
Kakko-Chiloff	5,058,472	Oct. 22, 1991
Swiss patent (Swiss '931)	326,931	Jan. 15, 1958 ²
European patent (EP '559)	234,559	Feb. 25, 1987 ²

THE REJECTIONS

Claims 1-6 and 17-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kakko-Chiloff in view of EP '559 and Bell.

Claims 7-9 and 21-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kakko-Chiloff in view of EP '559, Bell and Swiss '931.

²Translations enclosed.

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Claims 10-12, 14-16 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kakko-Chiloff in view of EP '559, Bell and Fokos.

Claims 13 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kakko-Chiloff in view of EP '559, Bell, Swiss '931 and Fokos.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the APPLICANT'S NEW BRIEF.

OPINION

All of the claims stand rejected under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching,

suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

We shall look first to the rejection of independent claim 1. According to the examiner, Kakko-Chiloff discloses an apparatus that meets all of the limitations of this claim except for the inwardly tapered recesses in each end of the die cylinders and the corresponding tapered sidewalls in the arbor assemblies which support the die cylinders at each end, and the requirement that each die cylinder and its associated arbor assemblies be separately removable from the guide ways of the die stand. For the tapered recess limitation the examiner looks to EP '559, and for the separate removability to Bell.

Kakko-Chiloff is directed to a rotary cutting apparatus having a pair of cooperating die cylinders, each comprising a central roller portion flanked by a pair of axially aligned and extending stub shafts, which are received in the supporting bearings. Interestingly, this is precisely the prior art construction over which the appellant believes his invention to be an improvement (specification, page 1). The objective in

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Kakko-Chiloff is to maintain the alignment and the spacing of a pair of die cylinders even in the face of removing them and replacing them with a new set. As stated in column 2:

With a view of reducing the adjustment idle times, all these considerations lead to provide, for each new format, a complete interchangeable cutting device or "cassette" including, in addition to the cylinders for format cutting, all the other elements necessary for the cutting operation.

The patentee goes on to explain that the "cassette" comprises upper and lower cutting cylinders (6 and 7) and the two pairs of blocks (24 and 25) that support them, which are attached together by a resilient coupling device (26) and installed or removed as a unit (column 3, line 56 *et. seq.*). Thus, in the Kakko-Chiloff construction, the cylinders and their associated arbor assemblies are not separately removable, as is required by claim 1.

Bell discloses a rotary die machine in which the cylinders and their arbor assemblies are separately removable, a fact that is not explicitly stated, but is immediately recognizable as being the case when one considers the description and operation of the structure disclosed, with particular reference to column 3. The examiner's position is that one of ordinary skill in the art would have found it obvious to replace the "cassette" of the primary reference, in which both cylinders and their arbors are

connected together and are removed and inserted together, with a pair of unconnected, separate cylinders. We think not. Such a modification would have destroyed the very essence of the Kakko-Chiloff invention, and we therefore are of the view that this would have served as a disincentive for the artisan to make the modification proposed by the examiner. We further observe that the Bell cylinders also are of the type in which stub shafts extend outwardly from the central roller portions.

EP '559 was cited for its showing of mounting a pair of die cylinders on tapered arbor assembly sidewalls which cooperate with tapered recesses in the cylinders. Be that as it may, this reference fails to overcome the objection we have raised above with regard to the lack of motivation to combine the teachings of Kakko-Chiloff and Bell.

For the reason expressed above, we agree with the appellant that the only suggestion for combining the references in the manner proposed by the examiner resides in the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). It therefore is our conclusion that the teachings of the three references cited against claim 1 fail to establish a *prima facie*

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case of obviousness with regard to the subject matter recited in the claim, and we will not sustain the rejection.

Independent claim 17 stands rejected on the basis of these three references, also. Our position with regard to it is the same, that is, we will not sustain the rejection for the reason set forth above with regard to claim 1.

Claim 7, the third of the independent claims, has been rejected on the basis of Kakko-Chiloff, EP '559 and Bell, taken further with Swiss '931, which was added for its teaching of utilizing a drawbar extending axially completely through the die cylinder. This reference also fails to overcome the problem we voiced above with regard to Kakko-Chiloff and Bell, and the rejection also cannot be sustained.

Likewise, the addition of the Fokos patent to the various rejections fails to overcome the problem.

Since the rejections of the independent claims cannot be sustained, it follows that those of the dependent claims also must fall.

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SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior)	
Administrative Patent Judge))	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge))	

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